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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,735	08/06/2001	Masaru Kihara	249-187	3183

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EXAMINER

CREPEAU, JONATHAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/925,735

Applicant(s)

KIHARA ET AL.

Examiner

Jonathan S. Crepeau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office action addresses claims 1-4, 6, and 7. Claims 6 and 7 are newly rejected under 35 USC 103, as necessitated by amendment. Claims 1-4, 6, and 7 are also newly rejected under 35 USC 112 first paragraph, as also necessitated by amendment. Claims 1-4 contain allowable subject matter as currently drafted. Accordingly, this action is made final.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 2 have been amended to recite “ δ -NiOOH.” This appears to be a typographical error and should be changed to “ γ -NiOOH.”

Claims 1, 2, and 3 have been amended to recite that the oxidizing step produces an average valence greater than 2.3, and that the reducing step produces an average valence not

greater than 2.3. These recitations are also considered to constitute new matter into the application. Throughout the specification, it is disclosed that the average valence after reduction should not be greater than 2.3, *but also that the valence should not be less than 2.1*. As the new claim language encompasses values below 2.1, the new language is considered to be broader than what is supported by the originally filed application. Similarly, with regard to the oxidizing step, the originally filed application supports an average valence of 2.8 but not a range of “greater than 2.3” in general. As such, these recitations are considered to constitute new matter.

Claim Rejections - 35 USC § 103

4. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as obvious over Ovshinsky et al (U.S. Patent 5,523,182) in view of JP 11-144723.

In column 26, line 45 et seq., Ovshinsky et al. teach a method of preparing a positive active material by chemically oxidizing nickel hydroxide and then either chemically or electrochemically reducing it. Regarding claim 6, a positive electrode comprises a porous substrate and a slurry of the active material and a binder (see col. 10, lines 31-37; col. 21, lines 44-50). Regarding claim 7, an alkaline storage battery comprises the positive electrode, a negative electrode, a separator, and an alkaline electrolytic solution (see col. 6, line 25; claim 5 of the reference). While Ovshinsky does not appear to teach the presence of β -NiOOH in the active material, such compound would naturally be formed upon performing the method of Ovshinsky.

Ovshinsky does not expressly teach that the average valence of the final product is not greater than 2.30, as recited in claim 1.

In the abstract, JP 11-144723 teaches a nickel hydroxide active material having an average nickel valence of 2.1 to 2.3.

Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made because the disclosure of JP '723 would motivate the artisan to adjust the average valence of the nickel hydroxide of Ovshinsky et al. to be in the range of 2.1 to 2.3. In the abstract, JP '723 discloses that this "increase[s] the discharge capacity in a high-rate discharge of a battery." Accordingly, this would sufficiently motivate the artisan to adjust the average valence of the nickel hydroxide of Ovshinsky et al. to be in the range of 2.1 to 2.3.

Further, claims 6 and 7 are considered to be product-by-process claims. Although Ovshinsky and JP '723 do not teach some of the claimed process limitations (i.e., the specific reducing agents), the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Accordingly, claims 6 and 7 are not considered to be distinguished over the references.

Allowable Subject Matter

5. Claims 1-4 contain allowable subject matter as currently drafted, but are rejected under 35 USC 112, first paragraph as set forth above.

6. The following is a statement of reasons for the indication of allowable subject matter:

Claims 1, 2, and 3 currently recite that the oxidizing step produces an average valence of greater than 2.3. Neither Ovshinsky nor JP '723 teaches or fairly suggests this limitation.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Crepeau whose telephone number is (571) 272-1299. The examiner can normally be reached Monday-Friday from 9:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr, can be reached at (571) 272-1414. The phone number for the organization where this application or proceeding is assigned is (571) 272-1700. Documents may be faxed to the central fax server at (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jonathan Crepeau
Primary Examiner
Art Unit 1746
July 14, 2005